

Appl. No.: 10/518,222
Reply to Office Action of: 03/20/2009

REMARKS

Claims 11-14 were rejected under 35 U.S.C. 102(b) as being anticipated by Stevens-Wright (US 5,383,852). Claims 1-10 and 19-20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Grabover (US 5,938,588) in view of Stevens-Wright (US 5,383,852). Claims 15-17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Stevens-Wright (US 5,383,852) in view of Grabover (US 5,938,588). The examiner is requested to reconsider these rejections.

In view of the examiner's comments regarding the language "adapted to" and "can be", claim 11 has been amended above. Independent claim 11 claims that the first and second active deflection sections are configured to deflect such that a distal end of the nephroscope is configured to be placed in a calyx of a lower pole of a kidney without the need to passively deflecting the front end of the shaft against tissue of the kidney of a patient to reach the calyx of the lower pole.

Note also that claim 11 claims that the first and second active deflection sections are each limited to deflection in a single plane relative to each other. Nowhere in Stevens-Wright is there a disclosure or suggestion that the two sections 15, 16 are each limited to deflection in a single plane. Section 15 can deflect vertically and horizontally. Section 16 can deflect vertically and horizontally. Merely because the controls (the pull cables 32) only "actively" deflect section 15 horizontally and section 16 vertically,

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this does not mean that sections 15 and 16 are each limited to deflection in a single plane.

Stevens-Wright teaches that the controls (pull cables 32) can actively deflect the sections 15 horizontally and the section 16 vertically. However, the construction of the active deflection control system described in Stevens-Wright does not teach limiting deflection to only a single plane for section 15 or limiting deflection to only a single plane for section 16. Section 15 can "passively" deflect vertically (even though the pull cables 32 can "actively" deflect it horizontally), and section 16 can "passively" deflect horizontally (even though the pull cables 32 can "actively" deflect it vertically). There is no disclosure or suggestion of the sections 15, 16 each being limited to deflection in a single plane.

The sections 15, 16 have a core with lumens, but the cores appear to be polymer material and can bend in more than one plane. These cores can deflect in more than one plane. Note column 6, lines 27-31 which discusses differential in hardness between sections 15 and 16. Stiffening wires 43 are added to reduce axial twisting of section 15, but there is no disclosure or suggestion of limiting deflection to a single plane. Section 15 can deflect in more than one plane. Section 16 can deflect in more than one plane. The examiner appears to be reading applicants' teachings into Stevens-Wright. There is no disclosure or suggestion in Stevens-Wright of section 15 being limited to a single plane of deflection and section 16 being limited to a single plane of

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deflection. Thus, Stevens-Wright does not "anticipate" the features of claim 11.

In regard to the obviousness rejections of claims 15-17, these do not appear to be supported by the cited art. Grabover discloses a wire sheath 50 made from a shape memory alloy, but there is no disclosure or suggestion of section 16 having a first shape memory alloy member and section 18 having a second shape memory alloy member. Nor is there a suggestion of a curved pre-shaped home position (claim 16, and see Fig. 11). Nor is there a suggestion of the curved pre-shaped home position being maintained in a straight position by tension (claim 17). The examiner's rejections of claims 15-17 are not supported by the cited art.

Though the claims dependent upon claim 11 contain their own allowable subject matter, these claims should at least be allowable due to their dependence from allowable claim 11. However, to expedite prosecution at this time, no further comment will be made.

Independent claim 1 claims that the first active deflection section is limited to deflection in a first plane and the second active deflection section is limited to deflection in a second different plane. Neither Grabover nor Stevens-Wright disclose or suggest this. In Grabover the two deflections sections 16 and 18 can deflect in any suitable direction. The control system can cause the active deflection section 18 to actively deflect in a single plane (for example horizontal), but there is no disclosure or suggestion of limiting deflection to only that plane. The active deflection section

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18 could passively deflect vertically. Likewise, in Stevens-Wright the section 15 can passively deflect vertically (even though the pull cables 32 can actively deflect it horizontally), and the section 16 can passively deflect horizontally (even though the pull cables 32 can actively deflect it vertically). There is no disclosure or suggestion of the sections 15, 16 being limited to deflection in a single plane.

Thus, even if it was obvious to combine the teachings of Stevens-Wright with Grabover, this still would not have suggested applicants' claimed invention, because there still is no disclosure or suggestion of a first active deflection section is limited to deflection in a first plane and a second active deflection section is limited to deflection in a second different plane. The features of claim 1 are not disclosed or suggested in the cited art. Therefore, claim 1 is patentable and should be allowed.

Though the claims dependent upon claim 1 contain their own allowable subject matter, these claims should at least be allowable due to their dependence from allowable claim 1. However, to expedite prosecution at this time, no further comment will be made.

Independent claim 19 claims a first active deflection section is limited to deflection in a first plane and a second active deflection section is limited to deflection in a second different plane. Nowhere in Stevens-Wright is there a disclosure or suggestion that the two sections 15, 16 are each limited to deflection in a single plane. Certainly, the

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controls (pull cables 32) actively deflect the two sections 15, 16 vertically or horizontally. However, active control of deflection does not teach limiting deflection to only a single plane. The section 15 can passively deflect vertically (even though the pull cables 32 can actively deflect it horizontally), and the section 16 can passively deflect horizontally (even though the pull cables 32 can actively deflect it vertically). There is no disclosure or suggestion of the sections 15, 16 being limited to deflection in a single plane. Likewise, in Grabover, the active deflection section 18 might only be designed to "actively" deflect in a single plane by pulling on the wires 24. However, there is no disclosure or suggestion that it cannot "passively" deflect in another plane. There is no disclosure or suggestion of a first active deflection section is limited to deflection in a first plane and a second active deflection section is limited to deflection in a second different plane.

Thus, even if it was obvious to combine the teachings of the two references, they still would not suggest applicants' invention as claimed in claim 19 because a combination of the references still would not suggest a first active deflection section is limited to deflection in a first plane and a second active deflection section is limited to deflection in a second different plane. Therefore, claim 19 is patentable and should be allowed.

In regard to claim 20, nowhere in the cited art is there a disclosure or suggestion of a connecting member extending through holes in all of the ball sections on one of the sides of the claimed rings. The examiner has not establish a prima

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facie case of obviousness. Claim 20 is patentable and should be allowed.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issue remain, the examiner is invited to call applicants' attorney at the telephone number indicated below.

Respectfully submitted,

Mark F. Harrington

Mark F. Harrington (Reg. No. 31,686)

5/12/09
Date

Customer No.: 29683
Harrington & Smith, PC
4 Research Drive
Shelton, CT 06484-6212
203-925-9400

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